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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,396	09/24/2001	Stephen McCann	3036/50289	5628
7590 Crowell & Moring L.L.P. Intellectual Property Group P.O. Box 14300 Washington, DC 20044-4300		EXAMINER WILLIAMS, JEFFERY L.		
		ART UNIT 2437		
		MAIL DATE 04/30/2009		
		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

09/960,396

**Applicant(s)**

MCCANN ET AL.

**Examiner**

JEFFERY WILLIAMS

**Art Unit**

2437

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 - 9, 11 - 15, and 21 - 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 - 9, 11 - 15, and 21 - 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

This action is in response to the communication filed on 11/9/07.

All objections and rejections not set forth below have been withdrawn.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2 – 9, 21, and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 28 recites the limitation "...the requested access to the first W-LAN by the portable computing device..." in lines 1 and 2. There is insufficient antecedent basis for this limitation in the claim. For the purpose of examination, the examiner presumes the applicant to mean "...the requested access to the first W-LAN ..."

Furthermore, claim 28 recites, "...the requested access to the first W-LAN ... is performed independently of the mobile telephone" in lines 1 – 3. This recitation is ambiguous as the system for the "requested access" claim clearly comprises recitations necessitating the usage of a mobile telephone (see for example, claim 1, lines 6, 13, 14, and 16).

Claims 2 – 9 and 21 are rejected by virtue of dependency.

***Claim Rejections - 35 USC § 103***

**Claims 1 – 9, 11- 15, and 21 - 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rai et al. (Rai), “Registration Scheme for Network”, U.S. Patent 6,675,208 in view of Turunen, “Mobile Internet Access”, U.S. Patent 6,477,644, in view of Anderson, “Sending Initial Password Through an SMS”, WO 01/15462 A1.**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Regarding claim 1, Rai discloses:

*a user requesting visiting access to the first W-LAN (Rai, fig. 3) and having a mobile telephone, a valid cellular mobile account for the mobile telephone, a portable computing device with a browser (Rai, 5:11-14,20-24,56-66), and a registration with a second W- LAN operator that administers a home authentication, authorization and accounting (HAAA) server (Rai, fig. 16:”Home Wireless Service Provider; 28:11-40), conveys to the VAAA server, by user intervention, identity information sufficient to enable said VAAA server to communicate with said HAAA server so as to authenticate*

1 *the proposed connection (Rai, 9:21-25, 10:5-14) ... the cost of such access is billed to*  
2 *the user's cellular mobile account (Rai, 28:11-40; 36:25-58).*

3 Rai discloses a system for allowing roaming users with mobile stations to visit  
4 WLANs and receive network services. Rai further discloses that to gain mobile IP  
5 access after registration, a roaming user must authenticate to a home server using  
6 authentication data (17:33-40). Rai, however, does not appear to explicitly recite *said*  
7 *HAAA issues a personal identification number (PIN); the PIN is encoded and forwarded*  
8 *to the user's mobile telephone.*

9 Turunen also discloses methods to allow a roaming user with a mobile telephone  
10 and portable computing device to gain mobile internet access (Turunen, Abstract; 1:36-  
11 49). Turunen teaches methods for distributing authentication data to roaming users so  
12 that roaming users may gain mobile internet access. The method comprising the home  
13 server issuing *a personal identification number (PIN); the PIN is encoded and forwarded*  
14 *to the user's mobile telephone* (Turunen, 5:49-66).

15 It would have been obvious to one of ordinary skill in the art to employ the  
16 methods of Turunen within the system of Rai. This would have been obvious because  
17 one of ordinary skill in the art would have been motivated by the teachings that such a  
18 method increases the security of a system enabling mobile internet access (Turunen,  
19 4:31-43; 5:49-66).

20 The combination enables roaming users possessing a mobile telephone and  
21 portable computing device to gain mobile internet access and the secure provision of

1 authentication data to roaming users. However, the combination does not appear to  
2 explicitly recite that the authentication data is *transferred to the browser*.

3 Anderson similarly discloses a system that securely provisions authentication  
4 data to an end user possessing a mobile telephone and portable computing device  
5 (Anderson, fig. 1). Anderson teaches that a mobile user submits provisioned  
6 authentication data to a web server using his web browser (Anderson, pg. 5, line 32 –  
7 pg. 6, line 2; pg. 6, lines 17-26). Thus, Anderson enables transferring authentication  
8 data from a mobile phone to a web browser, and accessing services utilizing the web  
9 browser of the portable computing device.

10 It would have been obvious to one of ordinary skill in the art to employ the  
11 teachings of Anderson within the combination of Rai and Turunen. This would have  
12 been obvious because one of ordinary skill in the art would have been motivated by the  
13 need to practically provide a means to enable users with portable computing devices to  
14 submit authentication data that has been received by their mobile telephone.

15  
16 Regarding claim 2 the combination enables:

17 *wherein the transfer of the PIN to the browser is effected manually by the user*  
18 (Anderson, pg. 5, line 32 – pg. 6, line 2; pg. 6, lines 17-26).

19  
20 Regarding claim 3 the combination enables:

21 *wherein the portable computing device is coupled to the mobile telephone*  
22 (Turunen, 1:36-40). The combination does not explicitly recite automatic means to

transfer authentication data, however, it was well known to those of ordinary skill in the art to apply automatic means to accomplish manual tasks.

Regarding claim 4 the combination enables:  
*wherein the PIN issued by the HAAA is encoded and forwarded to the user's mobile telephone by means of a short message service centre* (Turunen, 5:49-66).

Regarding claim 5 the combination enables:  
*wherein the user employs the browser to convey said identity information, via the first W-LAN, to the VAAA* (Rai, 17:20-30).

Regarding claim 6 the combination enables:  
*wherein the PIN is combined with masking information* (Turuen, 5:61-66).

Regarding claim 7, the combination is silent regarding a random derivation of masking information. However, the examiner points out that it is well known in the art of encryption to employ random elements for purpose of security. The examiner notes that evidentiary textbooks such as Schneier, "Applied Cryptography, Second Edition", pg. 170-5, may be considered should the applicant feel necessary.

Regarding claim 8, the combination enables:

wherein the user calls the VAAA on the mobile telephone (Rai, 17:9-30). The mobile user communicates with the FA through a mobile telephone.

Regarding claim 9, the combination enables: *wherein the telephone call from said user is routed to the HAAA through a premium rate call unit (Rai, 6:6-16; 28:4-20).*

Regarding claim 21, the combination enables *wherein the portable computing device is coupled to the mobile telephone via a wireless link* (Rai, 5:56-67)

Regarding claim 28, the combination, as best understood, enables access using a portable computing device (Anderson, fig. 1).

Regarding claims 11 – 15, and 21 – 27, they are method and system claims comprising similar limitations as claims 1 – 9 and 28, and they are rejected, at least, for the same reasons.

### Response to Arguments

Applicant's arguments with respect to claims 1 – 9, 11- 15, and 21 - 27 have been considered but are moot in view of the new ground(s) of rejection.



***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

***See Notice of References Cited***

A shortened statutory period for reply is set to expire **3** months (not less than 90 days) from the mailing date of this communication.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFERY WILLIAMS whose telephone number is (571)272-7965. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Art Unit: 2437

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J. Williams

AU: 2437

/Emmanuel L. Moise/

Supervisory Patent Examiner, Art Unit 2437